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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1799	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____  Typed or printed name _____	Application Number 10/059,538		Filed January 29, 2002
	First Named Inventor Dale Knoop		
	Art Unit 2617	Examiner Huy Q. Phan	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,962</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			
		<p> Signature</p> <p>Richard A. Machonkin Typed or printed name</p> <p>(312) 913-0001 Telephone number</p> <p>May 4, 2007 Date</p>	

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Docket No. 1799)**

<b>In the Application of:</b>	)	
	)	
<b>Dale Knoop</b>	)	<b>Art Unit: 2617</b>
	)	
<b>Serial No.: 10/059,538</b>	)	<b>Examiner: Huy Q. Phan</b>
	)	
<b>Filed: January 29, 2002</b>	)	<b>Confirmation No. 5786</b>
	)	
<b>For: Method and System for Selecting</b>	)	
<b>Transmission Modes for Streaming</b>	)	
<b>Media Content to a Wireless Handset</b>	)	

**REASONS FOR REVIEW OF FINAL REJECTION**

Applicant requests review of the final rejection mailed on March 6, 2007, because the Examiner has clearly erred in rejecting the claims under § 103(a).

**1. The Claimed Invention**

Applicants' claims (of which claims 1, 18, 19, and 22 are independent) are directed to methods and systems for selecting a transmission mode for streaming media to a wireless handset. The independent claims all recite, in one way or another, the function of providing a set of choices indicating transmission modes for streaming media content to the wireless handset, wherein the set of choices is based on at least one presentation capacity of the wireless handset:

- Claim 1 recites "presenting on the wireless handset a set of choices indicating transmission modes for streaming media content to the wireless handset, wherein the set of choices is tailored based on at least one presentation capability of the wireless handset."

- Claim 18 recites “transmission-choice logic stored in the data storage and executable by the processor (i) to present on the screen display a set of choices indicating available transmission modes for streaming media to the wireless handset, wherein the available transmission modes are based at least in part on a presentation capability of the wireless handset.”
- Claim 19 recites “transmission-choice logic stored in the data storage and executable by the processor ... (i) to send to the wireless handset a set of choices indicating transmission modes available for streaming the media content to the wireless handset, wherein the set of choices indicating available transmission modes is based, at least in part, on a presentation capability of the wireless handset.”
- Claim 22 recites “providing the user with the list of permissible transmission modes for the selected media content choice, wherein the list of permissible transmission modes is tailored to the presentation capabilities of the wireless handset.”

## 2. Status of the Claims

Claims 1-11, 18-22, 24, and 25 are currently pending. Claims 1-11 and 18-22 stand rejected under § 103(a) as being unpatentable over Mosher et al., U.S. Pub. No. 2002/0099790 (“Mosher”) in view of Gourraud et al., U.S. Pub. No. 2002/0103881 (“Gourraud”). Claims 24 and 25 stand rejected over Mosher/Gourraud in combination with additional references.

## 3. The Examiner’s Clear Error

In the Final Office Action, mailed March 6, 2007, the Examiner relied on Gourraud as allegedly disclosing the claim elements quoted above. Specifically, the Examiner relied on Gourraud’s disclosure (e.g., in paragraph 41) of a *program list* from which the user can select a program to be viewed. *See* Final Office Action, pp. 2-3.

However, as Applicant has previously argued, Applicant's claims specify a set of choices indicating *transmission modes*, not *programs*. The Examiner's response to this argument has been to improperly equate transmission modes with programs, relying on Applicant's own specification:

Since, applicant specifies "a transmission mode" as "video only, audio only" (see applicant's specification page 9), it is interpreted a choice of programs as a choice of transmission mode.

See Final Office Action, p. 2; and

Since, applicant specifies "a transmission mode" as "video only, audio only" (see applicant's specification page 9), it is interpreted a program list as a list of permissible transmission modes.

See Final Office Action, p. 3.

The Examiner's reliance on Applicant's disclosure is a clear violation of the rule that an obviousness determination must be based on the prior art, not on Applicant's disclosure:

The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of facts gleaned from the prior art.

See MPEP § 2142; see also MPEP § 2145(X)(A)(explaining that a proper obviousness determination "does not include knowledge gleaned only from applicant's disclosure"). By relying on Applicant's specification as supposedly equating programs with transmission modes, the Examiner has clearly not reached a conclusion based only on facts gleaned from the prior art. For this reason alone, the Examiner's claim rejections are clearly erroneous.

Even if Applicant's specification were to be considered, Applicant's specification clearly distinguishes between programs and transmission modes. In particular, a program is *what* is transmitted, whereas a transmission mode specifies *how* the program is transmitted:

[A] given instance of media content can be stored as a single file in the media server's memory. The file can be transmitted to a wireless handset 100 using one or

more different transmission modes. A transmission mode generally specifies parameters used to send media content to the wireless handset 100.

See Applicant's specification, p. 9, lines 12-15. Thus, Applicant's specification indicates that the Examiner's position equating programs with transmission modes is clearly erroneous.

Moreover, when a "transmission mode" is properly understood as specifying parameters used to send media content, it is clear that Gourraud does not disclose providing a set of choices indicating transmission modes. For example, paragraph 32 of Gourraud discloses that the user chooses between programs P1 and P2. However, these programs are not transmission modes. As described in paragraph 32, the transmission mode is the RTP protocol that is used to stream the selected program (P1) to the terminal. The RTP protocol, however, was not indicated in a set of choices provided to the user.

Thus, Gourraud discloses a choice of *programs*, not a choice of *transmission modes*, much less a choice of transmission modes that is based on at least one presentation capability of the wireless handset. The Examiner's reliance on Gourraud is clearly erroneous.

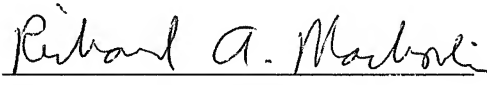
#### 4. Conclusion

For the foregoing reasons, Applicant submits that the Examiner's rejections of the pending claims are clearly erroneous and that all of the pending claims should be allowed

Respectfully submitted,

Dated: May 4, 2007

By:

  
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